



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,178	03/09/2001	William A. Pugh	41017.P001	4745
25943	7590	10/17/2005	EXAMINER	
SCHWABE, WILLIAMSON & WYATT, P.C. PACWEST CENTER, SUITE 1900 1211 SW FIFTH AVENUE PORTLAND, OR 97204			NGUYEN BA, HOANG VU A	
			ART UNIT	PAPER NUMBER
			2192	

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/803,178

Applicant(s)

PUGH ET AL.

Examiner

Hoang-Vu A. Nguyen-Ba

Art Unit

2192

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20-33 is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. In view of the appeal brief filed on July 26, 2005, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.
2. Claims 1-33 are now pending.

Response to Amendment

3. Per Applicant's request, Claims 34-37 have been canceled and Claims 4, 17, 23, 24 and 31 have been amended to correct previously undetected grammatical informalities.

Response to Arguments

4. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.
5. In response to Applicant's arguments with respect to Claims 23-33, the examiner notes that due to possible typographical error these claims were rejected in error in the Advisory Action dated February 3, 2005. The rejection of these claims is hereby withdrawn.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 17-19 are rejected under 35 U.S.C § 101 because the claimed invention is directed to non-statutory subject matter.

Under the most recent Federal Circuit cases, transformation of data by a machine (e.g., a computer) is statutory subject matter provided the claims recite a “practical application, i.e., ‘a useful, concrete and tangible result.’” State St. Bank & Trust Co. v. Signature Fin. Group, Inc., 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600-01 (Fed. Cir. 1998).

In this instance, the language of these claims raises a question as to whether these claims are directed merely to an abstract idea that is not tied to a machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis statutory subject matter under 35 U.S.C. § 101.

The Office’s interpretation of claims 17-19 is that these claims do not expressly or implicitly require performance of any steps by a machine, such as a general purpose digital computer. Structure will not be read into the claims for the purposes of the statutory subject matter analysis although the steps might be capable of being performed by a machine.

Adding the modifier computer-implemented before the limitation “method” in the preamble of the claim would however direct Claim 17 to statutory subject matter.

Claim Rejections – 35 U.S.C. § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3, 6-11, and 14-16 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,019,963 to Alderson et al. ("Alderson").

Claims 1, 7, 9 and 16

Alderson discloses *in an application service provision apparatus* (see at least FIG. 2, FIG. 3; item 11 and related discussion in the specification) *having an application service provision runtime library with multiple versions* (see at least FIG. 2, item 18; FIG. 3, item "Version 1," "Version 2;" and related discussion in the specification):

loading the latest version of the runtime library at initialization of the application service provision apparatus (see at least 4:1-18; the examiner respectfully notes that loading an application program and/or associated data files in the RAM of a computer system at initialization or booting time of a computer system is well known in the art; thus, loading the runtime library which is essentially a data file associated with service provision executable program at initialization of the claimed apparatus cannot be a distinguishing feature over the prior art in general, and over Alderson in particular);

during operation, receiving by a dispatcher a request for service for an application (see at least Abstract, lines 5-7; 3:40-42; 5:15);

in response, determining by the dispatcher whether the version of the runtime library required by the application is known to the dispatcher (see at least FIG. 3 where it is shown that version (a1, b1, c1) is not present, i.e., not known, in the host's object libraries comprising (a1, b2, c1) and (a1, b2, c2, d1); and

if the version of the runtime library required by the application is not known to the dispatcher, inquiring by the dispatcher with the latest version of the runtime library to learn of the required version of the runtime library (see at least FIG. 3 where it is shown that when the current version (a1, b1, c1) at the P.C. is not present in the host's

object libraries, the host will find the latest required version, i.e., version 2 (a1, b2, c2, d1) with which to upgrade the PC).

Claims 2 and 10

Alderson further discloses *the latest version of the runtime library informing the dispatcher which version of the runtime library is the required version of the runtime library, and the dispatcher caching the required version information* (see at least FIG. 3, step 3).

Claims 3 and 11

Alderson further discloses *the dispatcher routing the request of service to the application to handle if the dispatcher is informed by the latest version of the runtime library that the required version of the runtime library is the latest version itself* (see at least FIG. 3, step 3).

Claims 6 and 14

Alderson further discloses *the dispatcher routing the request for service to the application to handle if the required version of the runtime library is known to the dispatcher* (see at least FIG. 3, step 3 and related discussion in the specification).

Claim 8

The rejection of base claim 7 is incorporated. Alderson further discloses *loading the latest version of the runtime library at initialization of the application service provider apparatus* (see at least 4:1-18; the examiner respectfully notes that loading an application program and/or associated data files in the RAM of a computer system at initialization or booting time of the computer system is well known in the art; thus, loading the runtime library which is essentially a data file associated with service

provision executable program at initialization of the claimed apparatus cannot be a distinguishing feature over the prior art in general, and over Alderson in particular).

Claim 15

The rejection of Claim 9 is incorporated. Alderson further discloses *wherein the storage medium further having stored therein programming instructions to implement the plurality of versions of the runtime library* (see at least FIG. 2, item 19 and related discussion in the specification).

Claim Rejections – 35 USC § 103

10. The following is a quotation of the 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 4, 5, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,019,963 to Alderson et al. (“Alderson”).

Claims 4 and 12

Alderson does not specifically disclose *the dispatcher determining whether the required version of the runtime library is loaded if the required version is an earlier version of the runtime library, and if the required earlier version of the runtime library is not loaded, loading the required earlier version*. However, Alderson does teach that when a PC indicates that it does not contain a data file which should be included in the version of a program, the host can

supply the needed data file to the PC (see 5:36-41). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the aforementioned feature of Alderson to combine individual data files into a complete earlier version that can be made available to the PC by the host. One of ordinary skill in the art would have been motivated to modify Alderson in such a way to provide requester PCs with earlier versions of software that allow these PCs to communicate with peripheral devices (e.g., printer, plotter, etc.) that have not been updated to the state of the art.

Claims 5 and 13

The rejection of Claims 4 and 12 is respectively incorporated. Alderson further discloses *the dispatcher routing the request of service to the application to handle if the required earlier version of the runtime library is already loaded or upon loading the required earlier version of the runtime library* (see at least FIG. 3, step 3).

Allowable Subject Matter

12. Claim 17 is rejected as being directed to nonstatutory subject matter, but would be allowable if rewritten to overcome the 101 rejection.

13. Claims 18-19 are objected to as being dependent upon a rejected base claim, but would be allowable if Claim 17 is rewritten to overcome the the 101 rejection.

14. Claims 20-33 are allowed.

15. The following is an examiner's statement of the reason for allowance:

Alderson, taken individually or in combination, does neither teach nor suggest the specific limitations that are recited in independent Claims 20, 23, 27 and 30.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu "Antony" Nguyen-Ba whose telephone number is (571) 272-3701. The Examiner can normally be reached on the following days of a bi-week: Monday-Thursday (first week) and Tuesday-Friday (second week) from 7:15 to 17:45.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tuan Dam can be reached at (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**ANTONY NGUYEN-BA
PRIMARY EXAMINER**

Art Unit 2192

October 10, 2005